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In re Application of:	:	
NORDHOFF, Eckhard, et al.	:	DECISION
U.S. Application No.: 10/576,644	:	
Int'l Application No: PCT/EP2004/011878	:	
Int'l Filing Date: 20 October 2004	:	
Priority Date: 23 October 2003	:	
Atty Docket No.: 4020010060	:	
For: METHOD AND DEVICES FOR	:	
DEPOSITING SAMPLES ON AN	:	
ELECTRICALLY SHIELDED	:	
SUBSTRATE	:	

This decision is issued in response to the "Petition Under 37 CFR 1.48" filed 16 November 2007, treated herein as a request to correct inventorship under 37 CFR 1.497(d).<sup>1</sup> Applicants have filed the required \$130 processing fee.

**BACKGROUND**

On 20 October 2004, applicants filed international application PCT/EP2004/011878. The application claimed a priority date of 23 October 2003, and it designated the United States. On 06 May 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 23 April 2006. The published international application identified two applicant/inventors for the U.S.: Eckhard NORDHOFF and Alan BULLOCK.

On 21 April 2006, applicants filed a Transmittal Letter for entry into the U.S. national stage. However, this submission did not include payment of the basic national fee. Accordingly, this application became abandoned at midnight on 23 April 2006 for failure to timely file the basic national fee.

On 05 February 2007, applicants filed a petition for revival under 37 CFR 1.137(b).

On 06 February 2007, a decision was mailed granting the petition for revival.

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<sup>1</sup> 37 CFR 1.48 is not applicable to national stage applications which have not yet complied with the requirements of 35 U.S.C. 371(c). The applicable regulation for changing the inventors in such an application is 37 CFR 1.497(d).

On 09 August 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 16 November 2007, applicants filed a response to the Notification Of Missing Requirements that included payment of the required surcharge, a declaration executed by the two inventors of record and four additional inventors, and the petition considered herein. The petition requests that the four additional inventors listed on the declaration be added as inventors of record.

### **DISCUSSION**

Section 1893.01(e) of the MPEP states the following regarding changes in the inventorship of an international application entering the national stage (emphasis added):

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92*bis*. See 37 CFR 1.41(a)(4). Accordingly, **an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied.** These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

As noted above, applicants here have filed a declaration that names an inventive entity different than that set forth in the international application (specifically, the declaration includes four additional inventors: Christine LUBBERT, Antonin SCHENK, Holger EICHKOFF, and Martin HORN). Accordingly, applicants must satisfy the requirements of 37 CFR 1.497(d) before such declaration can be accepted.

The present request under 37 CFR 1.497(d) includes the required statements of non-deceptive intent from the four persons to be added as inventors, as well as the required processing fee. Requirements (A) and (B) are therefore satisfied. However, applicants have not submitted the written consent of the assignee to the requested change in inventorship (or provided a statement confirming that no such assignee exists). Requirement (C) is therefore not satisfied on the present record.<sup>2</sup>

Based on the above, applicants have failed to submit all the requirements of a grantable request under 37 CFR 1.497(d). Accordingly, the request to add Christine LUBBERT, Antonin SCHENK, Holger EICHKOFF, and Martin HORN as additional inventors of record is appropriately dismissed.

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<sup>2</sup> It is noted that the assignee's consent must be submitted in compliance with 37 CFR 3.73(b).

Based on the above, the declaration materials filed 16 November 2007 are not in compliance with 37 CFR 1.497(a) based on the failure to properly identify the inventors of record herein.

It is noted that the declaration materials filed 16 November 2007 are also defective in that the seven pages of declaration filed appear to be a compilation of multiple copies of a four-page declaration, and as such are not acceptable under 37 CFR 1.497 (See MPEP § 201.03(II)(B): "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration."). The compilation is evident from the fact that the declaration submitted includes one copy each of "Page 1" and "Page 2," but three different copies of "Page 3 of 4," and two different copies of "Page 4 of 4."

### CONCLUSION

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventorship of record herein remains that set forth in the international application, that is, Eckhard NORDHOFF and Alan BULLOCK.

The declaration materials filed 16 November 2007, which include four additional inventors, are defective on the present record for failure to properly identify and be executed by the inventors of record herein. In addition, as noted above, the declaration materials as submitted are also defective in that they appear to comprise an unacceptable compilation of multiple documents.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and must include: (1) the materials required to satisfy item (C) of a grantable petition, as discussed above and in the MPEP, that is, the written consent of the assignee to the proposed change of inventorship in the form required by 37 CFR 3.73(b) (or a statement confirming that no such assignee exists); and (2) copies of the complete declaration executed by each inventor.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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